UNITED STATES
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
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WASHINGTON, D.C. 20231
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SEP - 6 2001

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In re Application of :
Hubert Koster et al :
Serial No.: 09/171,625 : PETITION DECISION
Filed: July 2, 1999 :
Attorney Docket No.: 24743-2302US :

This is in response to applicants' petition under 37 CFR 1.144, filed April 26, 2001, requesting withdrawal of an improper lack of unity requirement. The delay in acting on this petition is regretted.

A review of the file history shows that this application was filed under 35 U.S.C. 371 as the National Phase of PCT/US97/06509 which claims priority to Provisional application 60/015,699, filed April 17, 1996. The application, as filed, contains claims 1-36. In a first Office action mailed September 5, 2000, the examiner set forth a restriction/lack of unity requirement under 35 U.S.C. 121 dividing the claims into four groups, as follows:

> Group I, claims 1, 3-4 and 11-16, drawn to a process of generating a combinatorial set of molecules of Core structure M;
> Group II, claims 2 and 5-16, drawn to a process of generating a combinatorial set of oligomers;
> Group III, claims 17-19, drawn to an olionucleotide made from monomers of structure 49a;
> Group IV, claims 23-35, drawn to a combinatorial set of compounds of Core structure M..

Claims 20-22 were inadvertently omitted and should have been grouped with Group III and claim 36 should have been grouped with Group IV. The examiner stated that the claims lack unity under PCT Rule 13.2 as they lack a common special technical feature. The examiner identified the special technical feature for each Group as: the process of generating a combinatorial set of molecules of structure M for Group I; the generating of oligomers for Group II; the oligonucleotide of structure 49a for Group III; and the combinatorial set of compounds of structure M for Group IV. The examiner further required an election of a disclosed species within each of the four groups above.

Applicants replied by electing Group I and traversing the Lack of Unity requirement on the basis that Group I should be combined with Group IV as the special technical feature, core M, is the same and that Group II should be combined with Group III as they both have as the special technical feature the oligomer. The sets are each related as product and process of making the product. Applicants also argued that the requirement for election of species in a Notional Phase application is improper in view of the PCT Rules.

The examiner in the next Office action, mailed February 26, 2001, maintained the restriction requirement for the reasons of record without directly addressing the election of species requirement and made the requirement Final. The examiner acted on claims 1, 3-4 and 11-16 rejecting them under 35 U.S.C. 112, first and second paragraphs and under 35 U.S.C. 102(b) as anticipated by Montal et al, Saul et al and Stengele et al. Applicants then filed this petition which again traverses the Lack of Unity requirement between Groups I and IV. Applicants appear to acquiesce in the restriction between Group I and IV and Groups II and III. Applicants continue to traverse the requirement for an election of species.

DISCUSSION

The applicable guidance for making lack of unity/restriction requirements is set forth below:

Annex B of the PCT Administrative Instructions gives guidance on Unity of Invention as follows:

(a) Unity of Invention. Rule 13.1 deals with the requirement of unity of invention and states the principle that an international application should relate to only one invention or, if there is more than one invention, that the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept.
(b) Technical Relationship. Rule 13.2 defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression special technical features is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).
(c) Independent and Dependent Claims. Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By dependent claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression category of claim referring to the classification of claims according to the subject matter of the invention claimed for example, product, process, use or apparatus or means, etc.).
(I) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. ****
(ii) If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity a posteriori (that is, arising only after assessment of the prior art) may be raised. ***
(iii) This method for determining whether unity of invention exists is intended to be applied even before the commencement of the international search. Where a search of the prior art is made, an initial determination of unity of invention, based on the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.
(d) Illustrations of Particular Situations. There are three particular situations for which the method for determining unity of invention contained in Rule 13.2 is explained in greater detail:

(I) combinations of different categories of claims;

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Principles for the interpretation of the method contained in Rule 13.2, in the context of each of those situations are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of Rule 13.2 . Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out below.

(e) Combinations of Different Categories of Claims. The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(I) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, *** it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product *** Thus, a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words specially adapted are not intended to imply that the product could not also be manufactured by a different process. Also an apparatus or means shall be considered to be specifically designed for carrying out a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. However, the expression specifically designed does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.

Applicants argue that the Lack of Unity requirement is improper in view of the fact that Groups I and IV have the same special technical feature, namely compounds of Core structure M and that they are related as product and process of making the product. Applicants are correct in their assertion. No Lack of Unity should have been made between the claims of Groups I and IV. The determination that the claims of Group I do not avoid the prior art, as set forth in the second Office action may infer a Lack of Unity does, in fact, exist. However, should the claims of Group I be later found to avoid the prior art, rejoinder of the claims of Group IV with those of Group I would be required. Thus it is better to conduct the examination of all of the claims of both groups concurrently with patentability of each Group being determined independently.

With respect to the requirement to elect a single disclosed species for purposes of examination, such is not within the provisions of PCT Rule 13. The examiner may hold that a claim contains more than one distinct invention within its scope based on differing special technical features (for example a fused carbocyclic ring structure and a fused heterocyclic ring structure in the same claim would support a determination that they are separate and distinct special technical features). However, the examiner herein has not alleged that there are multiple special technical features in any of the claims, but has held that core structure M, as suggested by applicants, is the special technical feature common to all of the compounds. This, however, does not forestall the examiner from requesting applicants' assistance in determining an initial proper field of search for the claimed invention(s), which may be expressed in a manner similar to an election of species or in other ways. However, for the examiner to maintain an election of species requirement or to limit the examination to only the preferred embodiment identified by applicants is improper. It is noted that although applicants traverse the election of species requirement set forth in the first Office in reply thereto, the examiner fails to comment on it except to correct an inadvertent omission with respect to the claims of Group IV. It does appear, however, that the examiner did not withdraw the election of species requirement.

Applicants argument that the examiner's making the Lack of Unity requirement Final in the second Office action is premature is not well taken. The Statute and Rules provide for an examination and reexamination of an application and that any action of the examiner which is repeated can be made a Final action. Herein, the second action, but first on the merits of patentability of the claims, had an affirmation by the examiner of the Lack of Unity requirement previously set forth and therefor could properly be made Final without the balance of the Office action being made Final.

DECISION

Applicants' petition is **GRANTED**. The Lack of Unity requirement with respect to Groups I and IV is withdrawn as is the requirement for an election of species. Groups II and III remain withdrawn from consideration as Lacking Unity of Invention with Groups I and IV.

**The application will be forwarded to the examiner for examination of the claims of Groups I and IV, claims 1, 3-4, 11-16 and 23-26.**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

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